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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/707,696

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David S. Smith

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EXAMINER

FIDEI, DAVID

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/707,696

Applicant(s)

SMITH, DAVID S.

Examiner

David T. Fidei

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3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rackley (US Patent no. 5,078,266) in view of Groomes (US Patent no. 3,871,519). Rackley discloses a carrying case for saw blades. At least two trays are defined by each of the case sections 11, 12 in as much as is claimed. What can be characterized as an annular insert 34, 36 are orthogonally and coaxially mounted within the respective cavities of each tray, see col. 4, lines 11-16. The inserts manifestly alter a diameter of each tray section 11, 12. The difference between claim 1 and Rackley resides in the case 10 being a generally circular case.

Groomes discloses a bingo carrying case similar in function and design as Rackley. Two case "tray" sections 11, 12 are hinged together to define an internal carrying cavity for retaining articles. The case has a generally circular shape as shown in figures 1 and 3. It would have been obvious to one of ordinary skill in the art to modify the case of Rackley by forming a generally circular case as taught by Groomes, as a matter of design choice for the reason that the shape of case is of no particular criticality as the device of Rackley would function equally well regardless of the particular shape used. The circular shape would have also better approximated the shape of the saws contained.

As to claims 2, Rackley discloses a pivot pin 27 mounted directed through the hinge mount of the base and lid, col. 4 lines 38-40 of Rackley.

As to claim 4, a pull mechanism 21, 22 in communication with the two trays is disclosed by Rackley in as much as is claimed.

As to claim 5, a latching mechanism 19, 20 is disclosed by Rackley.

As to claim 7, Rackley includes a handle 21, 22 in communication with the at least two storage trays 11, 12.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 2 above, and further in view of Leitner (US Patent no. 2,410,585). Leitner figure 2 is suggestive of two circular case sections hinged together along a circumference of each section 5, 6. It would have been obvious to one of ordinary skill in the art to provide circular hinged sections arranged as suggested by Leitner for the polygonal configuration of Rackley, in order to economize material by having a shape that better approximates the shape of the articles.

#### ***Response to Arguments***

4. Applicant's arguments filed November 22, 2006 have been fully considered but they are not persuasive. Since the patent to Leitner is only being applied to claim 3, this rejection is Non-Final.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

In establishing a prima facie showing of obviousness set forth above it is not seen where these factual inquiries have not been established.

Rackley is directly pertinent to the problem of the present disclosure in that the invention relates to the field of saw blade support structure, see col. 1, lines 6-10. Moreover, both Rackley and Groomes related to the container art with structure of similar design and function. Both are cases having hinged sections, the hinged sections are for holding articles within the case, both

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cases have hinged sections pivotally attached and both cases have a handle mechanism extending from each section. Accordingly, the scope and content of the prior art is defined.

As to the second inquiry, the above rejection resolves the difference between the closest prior art and claims at issue. That being a generally circular case rather than the polygonal case design of Rackley.

Finally, a finding of the ordinary skill level in an art is not an absolute requirement; not to do so is not fatal to a determination of obviousness if it does not improperly influence the determination e.g., (i) findings that the invention would have been obvious to those of the lowest level of skill, i.e., that of the layperson, or that the invention would have been non-obvious to those of extraordinary skill, i.e., other inventors in the art. *Kloster Speedsteel AB v. Crucible Inc.*, 230 USPQ 81 (Fed. Cir. 1986) on rehearing 231 USPQ 160 (Fed. Cir. 1986), or (ii) where the prior art itself reflects the appropriate skill level. *Litton Ind. Prods. Inc. v. Solid State Sys. Corp.*, 225 USPQ 34 (Fed. Cir. 1985).

Hence, it is submitted the Examiner has met the initial burden of establishing a prima facie conclusion of obviousness.

With regard to the claim including features not disclosed by Rackley, it is not agreed only one tray can be said to be formed by the case 10. Dictionary.com broadly defines a tray as; “a flat, shallow container or receptacle”. While one can construe the entire case as a tray there is nothing preventing one from also construing each case section, which is defined to include a cavity, as also being a tray. More importantly, there is nothing in the claimed subject matter limiting what one may consider a tray. As the Federal Circuit has observed, “the name of the game is the claim,” *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529(Fed. Cir. 1998) and absent subject matter defining otherwise it is not seen why each case section can not be considered a “tray” within the ordinary meaning of the term.

The same is also true of the “orthogonally and coaxially mounted” bosses 34, 36. Applicant argues these structures of Rackley are not removably mounted. First, there is nothing in the claim requiring the inserts to be removable. Secondly, it is not seen what would prevent one from removing the mounted bosses, as by cutting them off, if so desired. Applicant’s remarks in the capacity are not persuasive.


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Finally, with regard to the tenuous subject of suggestion or motivation for the combination it is respectfully submitted all of the prior art references employed above relate to pertinent concepts and relative features that would have been obvious to one skilled in the container art. Forming a generally circular case is shown to be known by those skilled in the container art. While the differences between Rackley and the claimed subject in this regard appear to be a matter of design choice, it can be said the circular shape better approximates the shape of the articles contained which provides a motivational basis.

### Conclusion

6. Any inquiry concerning this communication or earlier communications from the Examiner concerning the merits of the claims should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David T. Fidei  
Primary Examiner  
Art Unit 3728

dtf  
December 6, 2006